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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re RRF Industries

Serial No. 76/188,553

Myron Amer of Myron Amer, P.C. for RRF Industries.

R. Kenneth Williams, Trademark Examining Attorney, Law
Office 109 (Ronald R. Sussman, Managing Attorney).

Before Hanak, Hairston and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 29, 2000, RRF Industries (applicant) filed
an application to register the mark HEMINGWAY TRADERS (in
typed form) on the Principal Register for goods ultimately
identified as "men's sportswear, namely, shirts with front
pockets and plackets with stitching details" in
International Class 25.¹ The application alleges a date of
first use and first use in commerce of January 15, 1999.

¹ Serial No. 76/188,553.

The examining attorney finally refused to register the mark under Section 2(d) of the Trademark Act because of a registration of the mark HEMINGWAY (in typed form) for "men's and women's outdoor clothing namely, underwear, swimwear, pajamas, nightgowns, robes, socks, shirts, T-shirts, sweatshirts, sweaters, pants, sweatpants, dresses, skirts, shorts, jumpsuits, jackets, raincoats, vests, hats, gloves, ties and scarves" in International Class 25.² 15 U.S.C. § 1052(d). The examining attorney determined that there would be a likelihood of confusion when the marks HEMINGWAY TRADER and HEMINGWAY are used on the identified goods.

After the examining attorney made the refusal final, this appeal followed.

The examining attorney's position is that the "registrant's shirts are not limited by this identification, and the registrant's shirts may include 'men's sportswear, namely, shirts with front pockets and plackets with stitching details.'" Brief at 5. Regarding the comparison of the marks, the examining attorney argues that "Applicant's mark incorporates the entirety of the registrant's mark and adds the word TRADERS... A consumer

² Registration No. 1,384,390 issued on February 25, 1986. A Section 8 affidavit has been accepted.

encountering the marks in the market place is likely to view HEMINGWAY TRADERS to be simply a line of clothing originating from the same source as HEMINGWAY clothing." Brief at 2. Furthermore, the examining attorney held that while "Hemingway" is a surname frequently associated with the novelist Ernest Hemingway, a "surname can be a significant or co-equal portion of a trademark and must not always be totally disregarded in deciding a question of confusing similarity." Brief at 3. Because of the similarity of the marks and the identical and related nature of the goods, the examining attorney determined that there was a likelihood of confusion in this case.

Applicant maintains that "applicant's two word mark has a connotation that is not possessed by the one word cited mark." Brief at 4. Applicant further submits that it was error to conclude that "Hemingway" was the dominant part of applicant's mark and that "applicant's specifically styled goods" are likely to be confused with registrant's goods. Brief at 4. Finally, applicant concludes by arguing that there is no likelihood of confusion between "distinctly different goods using marks, considered in their entireties, that differ in sound, meaning and appearance." Brief at 5.

We affirm the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act.

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to the issue of whether the goods of applicant and registrant are related. The registration contains goods identified as "men's and women's outdoor clothing namely, ... shirts, T-shirts, sweatshirts." We reject applicant's argument that the fact that shirts is "preceded by a reference to 'women's outdoor clothing' and immediately following a reference to 'nightgowns', a traditional feminine article of clothing, does not warrant the examining attorney's statement that it must be assumed 'that the same classes of purchasers shop for [applicant's and registrant's goods].'" Brief at 5. Obviously,

registrant's goods are identified as "men's and women's outdoor clothing." Also, the order that registrant's lists its goods does not limit the goods in the list. While applicant has limited its shirts to those "with front pockets and plackets with stitching details," there is no limitation in registrant's identification of its goods that would exclude these types of shirts from registrant's goods. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"); In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) (Applicant's restaurant services identified as "restaurant services specializing in Southern-style cuisine" legally identical to registrant's restaurant services identified as "hotel, motel, and restaurant services"). Therefore, we consider that applicant's and registrant's goods are, in part, legally identical. See Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to

the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Also, because there are no restrictions in the registration as to the channels of trade and applicant's goods would be included within registrant's goods, we must assume that the goods travel in the same channels of trade and are purchased by the same purchasers. Kangol Ltd. v. KangaROOS U.S.A., Inc. 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992) (citation omitted) ("[I]n neither the applicant's application nor in the opposer's registration are the trade channels in any way restricted. The issue of likelihood of confusion is resolved by considering the 'normal and usual channels of trade and method of distribution.' In this case, regardless of whether or not golf shirts having collars are treated as being specifically different from athletic shirts, the goods are likely to be sold in department stores or specialty shops in close proximity to each other").

Next, we turn to the similarity of the marks. "If the services [or goods] are identical, 'the degree of similarity necessary to support a conclusion of likelihood of confusion declines.'" Dixie Restaurants, 41 USPQ2d at 1534, quoting, Century 21 Real Estate Corp. v. Century Life

of America, 970 F.2d 874, 877, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). The question here is whether the marks create the same commercial impression. The test is not whether the marks can be distinguished in a side-by-side comparison, but whether they are sufficiently similar in their overall commercial impression so that confusion as to the source of the goods marketed under the respective marks is likely to result. "[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Here, both marks contain the identical word HEMINGWAY in typed form. Applicant accuses the examining attorney of "dissecting of applicant's mark into the word HEMINGWAY and the word TRADERS." Brief at 3. As noted above, it is not improper to give weight to a particular feature of the mark for rational reasons. The examining attorney has made of record evidence that Ernest Hemingway was a noted American author and that a trader is defined as "one that trades; a dealer." The term "traders" when used with clothing is unlikely be viewed as the dominant portion of the mark because it is defined as including one that trades or a

dealer, in this case, of clothing items. This additional word in applicant's mark would likely be viewed as a further extension of the line of clothing sold under the registered mark. Adding an additional term to a registered mark does not necessarily result in overcoming the likelihood of confusion. Dixie Restaurants, 41 USPQ2d at 1534 (THE DELTA CAFE and design was confusingly similar to DELTA; more weight given to common dominant word DELTA); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 1022, 194 USPQ 419, 422 (CCPA 1977)(CALIFORNIA CONCEPT and design held likely to be confused with CONCEPT for hair care products); In re McWilliams, 200 USPQ 47, 49 (TTAB 1978)("While there may be a different connotation between the terms 'EDEN' and 'MT. EDEN' insofar as the word 'EDEN' might be interpreted as referring to the Biblical 'Garden of Eden,' whereas 'MT. EDEN' would refer to a particular mountain, we do not believe that such difference in meaning between the respective terms would have any significant bearing upon the minds of prospective purchasers of wine insofar as the commercial impression created by such terms are concerned").

We agree that when the marks HEMINGWAY TRADERS and HEMINGWAY are both used on shirts and other related clothing items, they do not create different commercial

impressions. Their differences in sound, appearance, and meaning are outweighed by their similarities. Prospective purchasers familiar with registrant's mark would likely believe that the same goods with applicant's mark would be associated or related to the source of registrant's goods.

Applicant also argues that there are two other registrations for the mark HEMINGWAY POINT owned by a different party. One of these registrations (No. 1,879,801) has expired. Even if this registration was considered confusingly similar, it would not justify issuing another confusingly similar registration. AMF Incorporated v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("[N]or should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion").

Here, the goods are identical and closely related and the marks are very similar, therefore, we conclude that there is a likelihood of confusion. We also note that if we had any doubts about the likelihood of confusion in this case, we must resolve these doubts in favor of the registrant and against the newcomer. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

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Decision: The refusal to register the mark under Section
2(d) is affirmed.